

Docket No. RSW920010117US1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTORS: David G. Kuehr-McLaren et al.

APPLICATION NO. 10/706,464

FILED: November 12, 2003

Examiner: J. Smith

CASE NO. RSW920010117US1

Group Art Unit: 3625

TITLE: METHOD, SYSTEM, AND COMPUTER PROGRAM PRODUCT
FOR FILTERING PARTICIPANTS IN ELECTRONIC
TRANSACTIONS USING PRIVACY POLICIES

CERTIFICATE OF MAILING

I hereby certify that this correspondence, along with any paper indicated as being enclosed, are being deposited with the United States Postal Service as first-class mail, postage prepaid, in an envelope addressed to: MAIL STOP AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on August 4, 2006.

August 4, 2006
Date

Barbara G. Makariou
Barbara G. Makariou

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

In response to the final Office Action of May 4, 2006 regarding the above-identified application, Applicant hereby requests review of the final rejection. No amendments are being filed with this Request.

This Request is being filed with a Notice of Appeal.

The review is requested for the reasons stated on the attached sheets.

REASONS FOR REQUEST

Applicant has filed a Notice of Appeal in the above-identified application. Applicant further requests a pre-appeal review of the examiners rejection of the above-identified application as Applicant believes the Examiner has failed to identify the presence of essential elements required to establish a *prima facie* rejection.

The MPEP and case law provide the following definition of anticipation for the purposes of 35 U.S.C. §102:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP §2131 citing *Verdegaal Bros. v. Union Oil Company of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987)

The Examiner Has Not Established a *Prima Facie* Case of Anticipation

As outlined in previous responses from the Applicant, such as the Reply mailed December 23, 2005, differences between the present claimed invention and the prior art of record have been discussed extensively. However, Applicant believes that the Examiner has failed to disclose where the prior art of record teaches a particular limitation of the claimed invention.

The present claimed invention focuses on improving security in an E-Marketplace for a consumer. This is accomplished, in part, by determining a consumer's privacy use information, comparing this privacy use information to those of the various vendors of the E-Marketplace, and only allowing transactions between a consumer and a vendor with matching privacy-use information.

Specifically, Claim 1 states the limitation of:

“only allowing transactions to occur between participants who have matching privacy-use information.”

Each additional independent claim (Claims 5 and 9) state a variation of this limitation.

This limitation is a primary point of divergence between the present invention and the prior art, including Epling. In the Final Action mailed May 4, 2006, the Examiner states “even if Epling involves a modification of original privacy-use policies the claim language still reads on this scenario inasmuch as the transaction does not occur until there is an agreement, i.e. a matching of privacy-use information.” However, the modification of privacy-use information in Epling is merely a transformation of the data from an XML document to a version that is readable by the user. The actual data stored in the privacy-use information remains unchanged.

Figure 2 of Epling illustrates the steps taken when checking the privacy-use information of a user and a web site the user wishes to access. Initially, the user’s privacy-use information is transformed into a viewable listing shown to the user. The individual requirements specified by the user can be ordered according to importance or just displayed as they are listed in the privacy-use file. The privacy policy information of the web site (e.g., does the web site give out your personal information such as email address, telephone number, name, etc.) and the privacy-use information of the user is compared. If there are no conflicts, the process allows the user to continue browsing the site. If there are conflicts, the system continues on with the web site accessing process. The listing previously presented to the user is now updated with indicators showing which individual privacy-use items are in conflict. The user has the opportunity to

review the results and decide if they still wish to view the site. Specifically, Epling paragraph [0050] states:

“After the user views the policy conflicts at block 220, the user may wish to exit the Web site (‘No’ branch, block 222) or continue to browse the Web site at block 224 (‘Yes’ branch, block 222).”

Ultimately, if the privacy-use information does not match, the user is responsible for deciding whether to visit the web site or not. This teaches away from the present claimed invention where the user can never access the web site if the privacy-use information does not match.

Figure 3 of Epling gives a detailed analysis of how the actual privacy-use information transformation, or modification, occurs. Specifically, each item in the user’s privacy-use information is read and compared against the privacy policy of the web site. If there is a conflict, the item is flagged. The listing of privacy-use items presented to the user can be re-arranged to display the flagged items first if desired, but the flagged items are never modified in the actual privacy-use file. Again, Epling states in the description of Figure 3 that the ultimate decision to access the web site is made by the user. Specifically, paragraph [0057] states:

“As a result of the processes described in Fig. 2 and Fig. 3, the user is presented with a set of user-focused privacy concerns instead of a company-based set of privacy concerns. As a result, furtive attempts to hide unpopular usage of personal data are defeated and the user can quickly determine if the user wants to access the web site.”

This citation distinctively illustrates how Epling fails to teach the presently claimed invention, specifically the limitation of only allowing transactions to occur between participants who have matching privacy-use information.

As noted above, each of the independent claims, and all claims depending therefrom, recite the claimed element, not taught or suggested by Epling, that transactions are allowed to occur

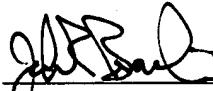
between participants only if they have matching privacy-use information. Accordingly, each of the independent claims, and all claims depending therefrom, patentably define over Epling and are in condition for allowance.

Conclusion

The present invention is not taught or suggested by the prior art. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of the claims. An early Notice of Allowance is earnestly solicited.

The Commissioner is hereby authorized to charge any fees associated with this communication to Deposit Account No. 09-0461.

Respectfully submitted,



John R. Brancolini
Registration No. 57,218

August 4, 2006

Date

SYNNESTVEDT & LECHNER LLP
2600 ARAMARK Tower
1101 Market Street
Philadelphia, PA 19107
Telephone: (215) 923-4466
Facsimile: (215) 923-2189